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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/932,364
Filing Date: August 17, 2001
Appellant(s): COCKRILL ET AL.

Kevin J. Zilka
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 23 January 2009 appealing from the Office

action mailed 11 March 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial

proceedings which will directly affect or be directly affected by or have a bearing on the

Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Non-Final

The appellant's statement of the status of amendments after non-final rejection

contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is

correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| 5,815,665 | Teper et al. | 29 September 1998 |
| 5,684,951 | Goldman et al. | 4 November 1997 |

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

2.   Claims 51, 53, 55, 58, 60, 61, and 64 are rejected under 35 U.S.C. 112, second

paragraph, as being indefinite for failing to particularly point out and distinctly claim the

subject matter which applicant regards as the invention.

As to independent claims 51, 58, and 64, a limitation reads: "wherein the method

/computer program / (a) and (b) is practiced on behalf of a first online service." The

language "on behalf of" is vague and indefinite.

As to dependent claims 53, 55, 60, and 61, these claims are rejected as being

dependent upon a rejected independent claim.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

4.   Claims 51, 53, 55, 58, 60, 61, and 64 are rejected under 35 U.S.C. 103(a) as

being unpatentable over Teper et al., U.S. Pat. No. 5,815,665, in view of Goldman et al.,

U.S. Pat. No. 5,684,951.

As to claims 51, 58, and 64, Teper discloses a method and system for identifying a user using a user computer system among a group of users (abstract) comprising:

(a) registering the user by (abstract):

(1) obtaining for the user a member identifier (abstract, columns 11-12, and claims 1, 8, 12, 15, 17, 20, 29, and 35) (abstract);

(2) after obtaining the member identifier, storing a unique identifier for the user on the user computer system in conjunction with the obtained member identifier (i.e. unique ID) (col. Line 67-col. 3, line 4); and

(b) identifying the user by (abstract):

(1) soliciting from the user the member identifier of the user (col. 3, lines 5-19, columns 11-12, and claims 1, 8, 12, 15, 17, 20, 29, and 35);

(2) receiving the member identifier of the user (col. 3, lines 5-19, columns 11-12, and claims 1, 8, 12, 15, 17, 20, 29, and 35);

(3) reading from the user computer system the unique identifier stored in conjunction with the member identifier received (The SP site forwards the response message to the online Broker Site along with the user's unique ID (which the SP site obtains from the user computer) (col. 3, lines 19-21, columns 11-12, and claims 1, 8, 12, 15, 17, 20, 29, and 35); and

(4) identifying the user using the unique identifier (See col. 3, lines 19-30). wherein the method is practiced on behalf of a first online service (i.e. Online Brokering Service) (abstract);

wherein obtaining for the user the member identifier comprises obtaining for the user a member identifier used by the user to identify the user to a second online service distinct from the first online service (i.e. service provider) (abstract, columns 11-12, and claims 1, 8, 12, 15, 17, 20, 29, and 35).

Teper does not specifically disclose wherein the unique identifier includes an email address.

However, Goldman teaches a method and system for performing user authorization in a multi-user computer system. Goldman stores a user ID, email address and IP for each registered user (See abstract, Figs. 3-9, and columns 5-11). It would have been obvious to combine Teper and Goldman for the motivation of making the authorization procedure more efficient and secure.

As to claims 52 and 59, Teper discloses wherein a plurality of users having the same user computer system are registered by repeating (a)(1)-(a)(2) for each of the plurality of users (i.e. An Online Brokering Service provides user authentication and billing services to allow users to anonymously and securely purchase online services from Service Providers (SP) sites) (abstract)

As to claims 53 and 60, Teper discloses wherein obtaining for the user the member identifier comprises:
soliciting from the user the member identifier of the user (See col. 3, lines 5-30) and receiving from the user the member identifier of the user (See col. 3, lines 5-30).

As to claims 55 and 61, Teper discloses wherein obtaining for the user the member identifier used by the user to identify the user to the second online service

comprises obtaining member identifier from an operator of the second online service

(i.e. SP site initiates a challenge-response authentication sequence) (col. 3, lines 5-19).

As to claims 56 and 62, Teper discloses wherein the user is first authenticated to

the first online service utilizing the member identifier, the unique identifier, and a

password of the user (See col. 6, lines 4-13).

(10) Response to Arguments

Issue #1: 35 U.S.C. 112, 2nd ¶: Independent claims 51, 58, and 64 and dependents

Appellant argues that the claimed "on behalf of" in all of the pertinent claims is to

be read with regards to its plain and ordinary meaning. Appellant also provides a

dictionary definition of "on behalf of": "[a]s the agent of; on the part of."

The Examiner respectfully disagrees. While the Appellant can of course assert

the plain meaning rule when the specification is silent with regards to a particular

limitation, in this case, it is unclear how the invention functions any differently when an

agent of a first online service practices it as opposed to the first online service itself

practicing the invention.

Issue #2: 25 U.S.C. 103(a): Independent claims 51, 58, and 64 and dependent 55

Appellant argues that Teper does not disclose "wherein the method is practiced

on behalf of a first online service." Appellant then argues on pages 12 and 13 that

Teper discloses two different sites, neither of which discloses the claimed limitation.

The Examiner does not dispute that Teper discloses both an online brokering site as

well as service provider sites.

The Examiner respectfully disagrees with Appellant's characterization of the claimed limitation. As discussed above, Appellant provided a dictionary definition for "on behalf of." One of the definitions is "on the part of." Certainly an entity can practice an invention on the part of itself. How else would an invention be practiced? Here is a simple example: a real estate broker purchases a new home on behalf of himself and his family. In this case at issue, the online brokering service of Teper is the first online service practicing the method. The online brokering service provides user authentication and billing services to allow users to anonymously purchase online services from service providers sites (web sites) over the internet (abstract). The online brokering service registers the user (abstract) and identifies the user (i.e. authenticates the user) (abstract). Therefore, the limitation is disclosed.

Appellant argues that Teper does not disclose:

(a) registering a user by: (1) obtaining for the user a member identifier; and (2) after obtaining the member identifier, storing a unique identifier for the user on a user computer system in conjunction with the obtained member identifier; and

(b) identifying the user by: (1) soliciting from the user the member identifier of the user; (2) receiving the member identifier of the user; (3) reading from the user computer system the unique identifier stored in conjunction with the member identifier received; and (4) identifying the user using the unique identifier.

The Examiner respectfully disagrees. Teper discloses the following:

(a) registering a user (abstract, col. 5, lines 26-30) by:

(1) obtaining for the user a member identifier (i.e. the Broker assigns a unique ID

that can be mapped to the user only by the Broker, and provides the user with the client

software components of the system. (col. 6, lines 1-13); and

(2) after obtaining the member identifier, storing a unique identifier for the user on

a user computer system in conjunction with the obtained member identifier (claim 4:

wherein the step of obtaining the password of the user comprises retrieving the

password from a password cache on the user computer, the password cache

temporarily storing the password following manual entry by the user, the method

thereby enabling the user to access multiple SP sites without re-entering the password);

and

(b) identifying the user (i.e. authenticating the user) (abstract) by:

(1) soliciting from the user the member identifier of the user: The SP site

forwards the response message to the Online Broker site along with the user's unique

ID (which the SP site obtains from the user computer) and the original challenge

message. The Online Brokering Service in-turn accesses the brokering database to

determine whether the response message was properly generated, and to thereby

authenticate the user. The Online Broker site then sends a message to the SP site

indicating whether or not the user was successfully authenticated. (col. 3, lines 19-27)

(2) receiving the member identifier of the user: The SP site forwards the

response message to the Online Broker site along with the user's unique ID (which the

SP site obtains from the user computer) and the original challenge message. The

Online Brokering Service in-turn accesses the brokering database to determine whether

the response message was properly generated, and to thereby authenticate the user.

The Online Broker site then sends a message to the SP site indicating whether or not

the user was successfully authenticated. (col. 3, lines 19-27)

(3) reading from the user computer system the unique identifier stored in

conjunction with the member identifier received: Claim 4: wherein the step of obtaining

the password of the user comprises retrieving the password from a password cache on

the user computer, the password cache temporarily storing the password following

manual entry by the user, the method thereby enabling the user to access multiple SP

sites without re-entering the password. (Claim 4) and

(4) identifying the user using the unique identifier: Upon determining that a user

is authentic, the Online Brokering Service preferably sends an anonymous session ID to

the SP site to allow the SP site to anonymously bill the user for services subsequently

purchased. As the user purchases online services (such as software downloads,

accesses to online publications, etc.), the SP site sends billing events to the Online

Brokering Service, with each billing event specifying both the anonymous session ID

and a charge to be applied to the user's account. The Online Brokering Service in-turn

applies such charges to the user's account. Advantageously, the user can later access

the Online Brokering site to view an account statement which shows all of the charges

from all of the registered SP sites accessed by the user. (col. 3, lines 31-45).

Teper also discloses where the user performs a single log-on using the

username and password established with the online brokering service, and then

accesses different service provider sites without having to perform a subsequent logon

(col. 4, lines 15-27). In addition, each service provider sites automatically customizes the user's particular access rights and customization preferences. These customization preferences allow the service provider sites to identify the users and provider the appropriates services.

Appellant argues that Teper does not disclose wherein obtaining for the user the member identifier comprises obtaining for the user a member identifier used by the user to identify the user to a second online service distinct from the first online service.

The Examiner respectfully disagrees. Teper discloses service provider sites (abstract) that are the second online service and are distinct from the online brokering service that is the first online service. Users in Teper are only anonymously identified to the service provider sites by an anonymous session ID (col. 11, lines 26-33) that allows users to purchase goods and services anonymously. This is in contrast to the online brokering service, which knows the actual identity of the user based upon information provided upon registration.

Appellant argues that Teper does not disclose wherein a plurality of users having a same user computer system are registered by repeating (a)(I)-(a)(2) for each of the plurality of users. It seems that the Appellant's interpretation of this limitation would be for multiple people to use the same exact computer. It is unclear to the Examiner how the invention would function any differently if for example, the Examiner practiced the claimed invention on his office computer and then another person took his place at the Examiner's computer to practice the claimed invention.

The Examiner respectfully disagrees that the limitation is not disclosed. Figure 1

of Teper clearly shows (below) multiple users each having a same user computer with a

client application and a brokering client. These multiple users use the Internet to

connect to the online brokering service and the service provider sites.

Fig. 1
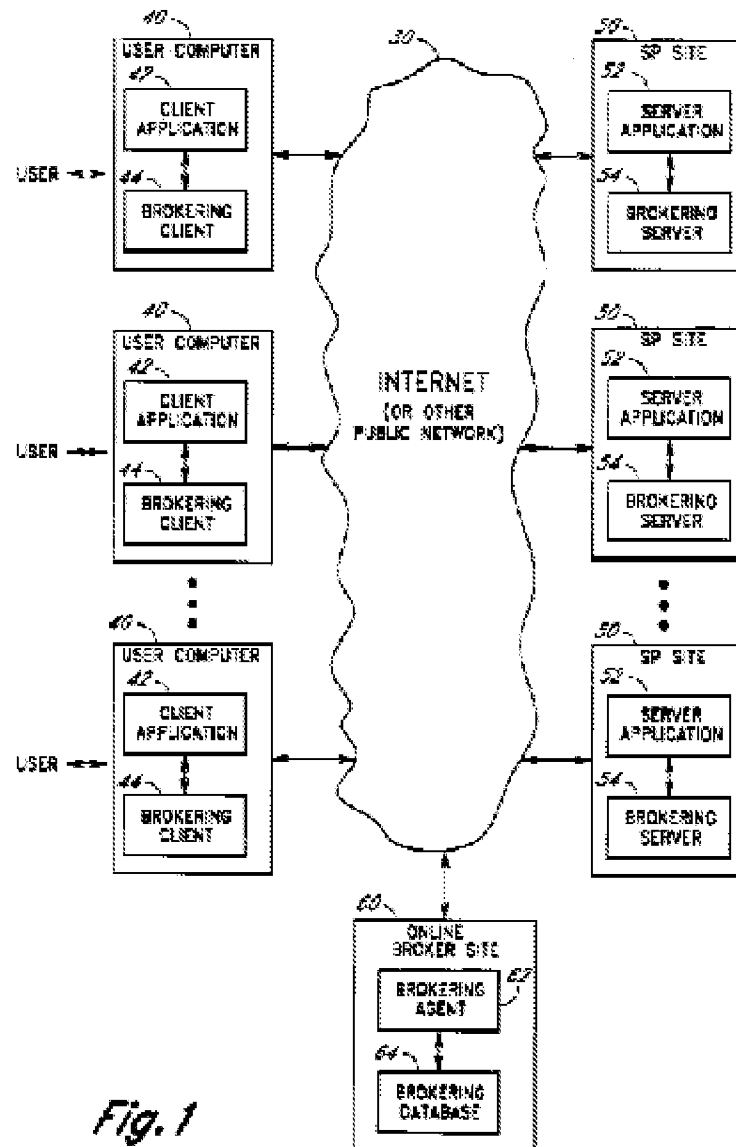
Appellant argues that Teper does not disclose wherein the user is authenticated

to the first online service utilizing the member identifier, the unique identifier, and a

password of the user.

The Examiner respectfully disagrees. As discussed above, Teper discloses that

a user is authenticated to the online brokering service (the first online service) with the

Unique ID assigned at registration, the password of the user, and the anonymous

session ID generated after connecting to a registered service provider site. The online

brokering service uses the Unique ID and password to identify and authenticate the

user based on the user's previous registration with the online brokering service. The

online brokering service then matches the user to transactions with the user and the

service provider sites by the anonymous session IDs and billing statements.

Consequently, the online brokering site must match all three identifiers: Unique ID,

password, and session ID, in order approve particular transactions.

Appellant argues that Goldman does not disclose wherein the unique identifier

includes an electronic email address.

The Examiner respectfully disagrees. Goldman teaches a method and system

for user authorization over a multi-user computer system including an application that

stores for each registered user an user identification, e-mail address, and an authorized

IP address (abstract). It would have been obvious to one skilled in the art at the time of

Appellant's invention to identify users in Teper with an e-mail address described by

Goldman because the combination would have yielded nothing more than predictable

results since the claimed invention is merely a combination of old elements.

As to claim 55, Appellant argues that Teper does not disclose wherein obtaining

for the user the member identifier used by the user to identify the user to the second

online service comprises obtaining member identifier from an operator of the second

online service.

The Examiner respectfully disagrees. Teper discloses tokens are assigned to

the Service Providers upon registration with the Online Brokering Service, allowing the

Service Providers to assign user-specific access rights to their respective SP services

and service areas (col. 15, lines 51-55). These tokens allow service provider sites to

specify user's particular access rights to specific services thereby identifying each user

by the privilege levels (col. 16,

  lines 6-19).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/SETH WEIS/
Examiner, Art Unit 3695

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